

REMARKS

In response to the outstanding Office Action, claims 1, 21 and 29 – 32 have been amended. Claim 20 has been cancelled. Thus, claims 1 – 19 and 21 – 32 remain pending in this application.

The Present Invention

The present invention is directed to a method and apparatus for generating and printing location patterns on a document. The location patterns are used to allow the positioning of a device, such as a pen, to be determined relative to the pattern.

The location patterns comprise a plurality of dots, each of which has a substantially predetermine size and nominal position in the pattern. The positions at which the dots are printed are constrained by the printer. Some of the dots are modified prior to printing such that the modified dots have an optical centre of gravity that more closely coincides with their nominal positions.

The Office Action

In the Office Action, the Examiner objected to informalities in Paragraphs 0055 and 0055 of the specification. These informalities have been corrected by way of the above amendment to each respective paragraph. Thus, it is respectfully requested that this objection be withdrawn.

The Examiner also objected to the drawings with respect to Fig. 1A. Fig. 1A has been corrected and a new drawing sheet is attached hereto as a replacement for the original drawing sheet that contained Fig. 1A. Thus, the objection to the drawings should be withdrawn.

Claim 28 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 28 has been amended in response to this rejection. Thus, the rejection should be withdrawn.

Claim 32 was rejected under 35 U.S.C. § 101. For the reasons set forth below, it is respectfully submitted that this rejection is improper and should be withdrawn.

With respect to the prior art, claim 30 was rejected under 35 U.S.C. § 102(g) as being anticipated by Wiebe et al. Claims 1 – 32 were rejected under 35 U.S.C. § 103(a) over Wiebe et al. and/or Fahraeus et al. in view of various combinations of secondary references. For the reasons set forth below, each of the rejections is traversed and should be withdrawn.

ARGUMENT

The Examiner has rejected claim 32 as being directed to non-statutory subject matter on the basis of printed matter. "[A] mere arrangement of printed matter, though seemingly a 'manufacture,' is rejected as not being within the statutory classes." [MPEP 706.03(a)]

However, claim 32 is not directed to a "mere arrangement of printed matter." Claim 32 recites "a location pattern arranged for use with a system." Claim 32 then goes on to describe the pattern in some detail. In addition, claim 32 has also been amended to recite that the location pattern is "adapted for printing with human-discernible content on the same carrier".

Thus, claim 32 is not merely directed to printed matter. Accordingly, it's rejection as being directed to non-statutory subject matter is improper and should be withdrawn.

With respect to the prior art, claim 30 was rejected under 35 U.S.C. 102(a) as being anticipated by Wiebe et al. The Examiner conceded with respect to the rejection of now cancelled claim 20 that Wiebe et al. does not teach the printing of a location pattern and human-discernible content on the same carrier. Claim 30 has been amended to add this limitation. Thus, the rejection of claim 30 as being anticipated by Wiebe should be withdrawn.

All of the remaining claims were rejected under 35 U.S.C. § 103(a) over Wiebe et al. and/or Fahraeus et al. in view of various combinations of numerous secondary references. In many cases, the Examiner has relied on as many as four references to form the rejection.

The sheer number of references required by the Examiner to reject the claims suggests, on their face, that the validity of the rejections are improper with respect to what a person of ordinary skill in the art would have known and been motivated to do. In no case has the Examiner shown that there is a suggestion in the references to combine them in the manner combined by the Examiner to reject the claims. Thus, Applicant traverses each of the rejections as being improper.

All of the dependent claims in this application have been amended to recited that the location pattern is adapted for printing with human-discernible content on the same carrier. Such a feature is not taught or suggested by any of the referenced cited by the examiner, alone or in combination.

In the Office Action, the Examiner incorrectly relies on Soules et al. as teaching such a feature. While Soules et al. discloses an identification card that has certain human readable information, the card does not include or suggest location pattern information. The only reference to a "pattern" disclosed by Soules is the person's finger print indicated by reference number 16 in Figure 1. See Col. 7, lines 21 – 23.

Thus, Soules et al., alone or in combination with any other cited references, does not disclose the present invention as described in the amended claims.

CONCLUSIONS

For above reasons, all claims in the instant application are believed to be in condition for allowance. An early indication of such allowance is respectfully requested.

Respectfully submitted,

ADORNO & YOSS LLP

A handwritten signature in cursive script, reading "William J. Jacob".

William J. Jacob
324 E. 11th Street
Suite 101
Kansas, City, MO 64106
Tel: 816-204-6430
Reg. No. 51,173